

Appln. Serial No. 10/609,060
Amendment Dated June 24, 2005
Reply to Office Action mailed March 31, 2005

REMARKS

Claims 11-24 are pending in the application.

Claims 11-24 have been rejected.

The Office Action rejected claims 13-14 and 20-21 under 35 U.S.C. § 112, second paragraph. Applicant has provided clarification in the remarks below. The Office Action rejected claims 11, 15, 17-18, 22, and 24 under 35 U.S.C. §102(b) as being allegedly unpatentable over U.S. Patent No. 5,854,621 by Junod et al. The Office Action further rejected claims 11-24 under 35 U.S.C. §103(a) as being allegedly unpatentable over U.S. Patent No. 6,782,245 by Lazzarotto et al. in view of U.S. Patent No. 5,854,621 by Junod et al. In view of the below remarks, Applicants respectfully believe all claims to be in condition for allowance.

I. ELECTION / RESTRICTIONS

In the Office Action, the Examiner restricted claims 1-24 as filed into group I claims 1-10 and group II claims 11-24. On 3/24/05, a provisional election was made telephonically without traverse to prosecute claims 11-24. Now pending are claims 11-24, the applicant having cancelled claims 1-10 without prejudice herein.

II. CLAIM REJECTIONS – 35 USC § 112

The Office Action rejected claims 13-14 and 20-21 under 35 U.S.C. § 112, second paragraph, as being allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Office Action stated that the claim scope was uncertain since a trademark or trade name cannot be used properly to identify any particular material or product.

Applicant respectfully asserts that a trademark or trade name is not used to identify a particular material or product. Furthermore, the claim scope, using the terms ‘Bluetooth’ and ‘USB’ is certain because the boundaries of the claims are capable of being understood by a person of ordinary skill in the art. Claims 13-14 and 20-21 are dependent claims that provide further limitations on the independent claims on which they depend.

Claims 13 and 20 do not use a trademark to identify or describe a particular material or product. In fact, the recited claimed limitation does not refer to a *particular material or product*. A person of ordinary skill in the art would understand the recited claim limitation of “Universal Serial Bus (USB) interface standard” to recite the use of a technical specification and the limitations of the technical specification therein. In fact, the *USB interface standard* provides the specific technical details to understand USB interface requirements and design products compatible with a USB interface. Accordingly, the recited claim limitation does not fail the test set forth in *Ex Parte Simpson*, 218 USPQ 1020 (Bd. App. 1982), because the claim scope is certain. [Versions of the USB specification may be found at <http://www.usb.org/developers/docs/>].

Similarly, regarding claims 14 and 21, a person of ordinary skill in the art would understand the recited claim limitation of “Bluetooth operating standard” to define a technical specification. The *Bluetooth operating standard* provides the technical details to understand Bluetooth wireless interface requirements and design products compatible with a Bluetooth wireless interface. Thus, the recited claim limitation “Bluetooth operating standard” is definite and does not use a trademark to identify or describe a particular material or product. Accordingly, the claim scope is certain. [Versions of the Bluetooth operating standard may be found at <https://www.bluetooth.org/spec/>].

In view of the above remarks, Applicants respectfully request withdrawal of the 35 U.S.C. § 112 claim rejections.

III. CLAIM REJECTIONS – 35 USC § 102

The Office Action rejected claims 11, 15, 17-18, 22, and 24 under 35 U.S.C. §102(b) as being allegedly unpatentable over U.S. Patent No. 5,854,621 by Junod et al. (Junod).

With respect to independent claims 11 and 18, Junod does not teach or suggest a host-side wireless interface where *the configuration information is also transferred to the host computer via the host interface*. Junod, at best, teaches merely that the “CPU 600 can then provide the appropriate signals to the host computer 30, such as a personal computer or workstation, through the PS/2 or serial host interface 610.” Junod, 9:15-18. Junod does not disclose what the “appropriate signals” are. A person of ordinary skill in the art would assume that Junod’s “appropriate signals” are merely control signals for the mouse (e.g., cursor and button control signals), because at the point that Junod is providing ‘appropriate signals’ to the host computer 30, Junod is no longer in the mode of *during configuration operations*. (emphasis added). This inference is supported by the distinct lack of discussion in Junod on the topic of communicating between the host interface 20 and the host computer 30. It is clear that Junod does not solve the problem of the present invention, and more to the point, doesn’t teach or suggest all of the elements in the recited claims. Accordingly, Junod doesn’t teach or suggest transferring *configuration information to the host computer during configuration operations*.

Applicant believes that dependent claims 15, 17, 22, and 24 are allowable for substantially the same reasons because they are dependent on allowable independent claims. Accordingly, Applicant respectfully requests withdrawal of the § 102 rejections.

IV. CLAIM REJECTIONS – 35 USC § 103

The Office Action rejected claims 11-24 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,782,245 by Lazzarotto et al. (Lazzarotto) in view of Junod.

The Office Action concedes that “Lazzarotto does not disclose the communication protocol wherein during the configuration operation, configuration information corresponding to the wireless user input is stored in the non-volatile memory and also transferred to the host computer via the host interface wherein during subsequent boot mode operations, the configuration information is retrieved from the non-volatile memory and used in servicing the user input device.” *Office Action* at 6.

Applicant respectfully asserts that the Office Action has failed to set forth a *prima facie* case of obviousness. With reference to remarks made above in Section III., Junod fails to teach or suggest a host-side wireless interface where *during configuration operations, the configuration information is also transferred to the host computer via the host interface.* (emphasis added). The lack of a teaching or suggestion for these recited claim limitations either singularly or in combination in either reference negates the basis for the rejection. Accordingly, Applicant respectfully submits that the Office Action has failed to set forth a *prima facie* case of obviousness and respectfully requests that the rejection of independent claims 11 and 18 be withdrawn. The dependent claims are allowable for substantially the same reasons.

V. CONCLUSION

Applicant believes the case is now in condition for allowance. Allowance of all claims is respectfully requested. The Commissioner is authorized to charge any additional fees and/or credit any overpayment to Deposit Account No. 50-2126 (BP2859).

Respectfully submitted,

GARLICK, HARRISON & MARKISON, LLP

Date: June 24, 2005

/Neil G. J. Mothew/
Neil G. J. Mothew, Reg. #54,922

Garlick, Harrison & Markison, LLP
P.O. Box 160727
Austin, TX 78716-0727
Telephone: (512) 264-8816
Facsimile: (512) 264-3735

CUSTOMER NUMBER: 51,472